

### REMARKS

This paper responds to the Office Action mailed on November 20, 2008. Applicants have not amended, canceled, or added claims. Consequently, claims 1-28 remain pending in this application.

#### § 101 Rejection of the Claims

Claims 1-14 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter for failing to include a required machine or transformation. Applicants respectfully traverse the rejection of claims 1-14 because independent claim 1 transforms data representative of physical objects.

In the recent *Bilski* case in the Court of Appeals for the Federal Circuit, the Court held that “[t]he machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article.” *In re Bilski*, 545 F.3d 943, 961, 88 USPQ2d 1385, 1403 (2008).

For the transformation test, the Court continued:

[The X-ray attenuation] data clearly represented physical and tangible objects, namely the structure of bones, organs, and other body tissues. Thus, the transformation of that raw data into a particular visual depiction of a physical object on a display was sufficient to render that more narrowly-claimed process patent-eligible.

We further note for clarity that the electronic transformation of the data itself into a visual depiction in Abele was sufficient; the claim was not required to involve any transformation of the underlying physical object that the data represented. We believe this is faithful to the concern the Supreme Court articulated as the basis for the machine-or-transformation test, namely the prevention of pre-emption of fundamental principles. *Id.* at 962-963.

Applicants' independent claim 1 recites, in relevant part:

A computer-implemented method for managing a change to a product structure comprising:

defining instructions *to implement the change to the product structure*; [and]

...

*automatically implementing the change* according to the first validity for the first organizational view, and according to the second validity for the second organizational view. (Emphasis added.)

Applicants assert that claim 1 meets the transformation test because the "product structure" data represent a physical object, namely a product<sup>1</sup>, and the claimed method transforms ("automatically implements the change") that data. The *Bilski* test does not require that the underlying physical object itself be transformed; transforming representative data is sufficient.

In *Abele*, the Court of Customs and Patents Appeals held unpatentable a broad independent claim reciting a process of graphically displaying variances of data. The broad claim did not specify any particular type or nature of data, nor did it specify how or from where the data was obtained or what the data represented. However, the Court held one of *Abele*'s dependent claims patentable where it specified that "said data is X-ray attenuation data produced in a two dimensional field by a computed tomography scanner" because the data represented physical and tangible objects.<sup>2</sup> Claim 1 is analogous to the patentable dependent claim in *Abele* because the product structure data represent physical objects. Since the Court of Appeals for the Federal Circuit in the *Bilski* decision held that *Abele*'s claim was patentable subject matter, claim 1 should also be

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<sup>1</sup> For example, "The product associated with the product structure 220 can include a specific product (e.g., a car) or a component of a product (e.g., a tire)." (See Applicants' published patent application (U.S. Published Patent Application No. 2005/0022156) at paragraph [0023].)

<sup>2</sup> See *In re Bilski*, 545 F.3d 943, 961, 88 USPQ2d 1385, 1403 (2008)

allowed. Applicants therefore assert claim 1 meets the transformation test and therefore represents patent eligible and statutory subject matter under 35 U.S.C. § 101.

Claims 2-14 are dependent on claim 1, and accordingly include the limitations of the claim from which they depend. Since claim 1 properly recites patentable subject matter, dependent claims 2-14 also represent patent eligible and statutory subject matter for at least the same reasons..

§ 102 Rejection of the Claims

Claims 1-29 were rejected under 35 U.S.C. § 102(b) as being anticipated by *Matheson* (U.S. Patent No. 6,944,514). Applicants respectfully submit that the Office Action did not make out a *prima facie* case of anticipation for the reasons articulated below.

In order to anticipate a claim, a reference must teach all limitations, arranged or combined in the same way as recited in Applicants' claim. The Court of Appeals for the Federal Circuit recently held

[U]nless a reference discloses within the four corners of the document not only all of the limitations claimed but also *all of the limitations arranged or combined in the same way as recited in the claim*, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.” (*Net MoneyIn, Inc. v. Verisign, Inc.*, No. 2007-1565 at 17. (Fed. Cir. Oct. 20, 2008.) Emphasis added.)

In the response to the previous Office Action, Applicants argued that *Matheson* failed to disclose “associating a first validity for the change with a first organizational structure” or “associating a second validity for the change with a second organizational structure” as recited in Applicants' claim 1. The current Office Action states in the *Response to Arguments* section, that “[a]s a result, Matheson indeed discloses an enhancement or improvement to an existing product (i.e., change, column 5, lines 21-25) that has to fulfill a plurality of requirements (i.e., validity)

from various organization structures (i.e., marketing, customers, engineering, manufacturing).”<sup>3</sup> However, neither these particular citations from *Matheson*, nor any other of the citations which the Examiner relies upon, disclose validities for a change as recited in claim 1.

In contrast to Applicants’ claim, *Matheson* describes a Product Idea, which “may be an idea for a new product, an enhancement or improvement to an existing product, or the solution to a known problem (such as an Engineering Change) for an existing product”<sup>4</sup> and a Product Requirement, which “encapsulates a requirement that the product must or should or could fulfill.”<sup>5</sup> These ideas and requirements are therefore tied to features of the products and are not tied to whether a potential change to the product is valid. Thus, *Matheson* merely discusses an enhancement or improvement to an existing product that has to fulfill a plurality of requirements. However, *Matheson* does not disclose, *inter alia*, “associating a first validity for the change with a first organizational structure,” “associating a second validity for the change with a second organizational structure,” or “automatically implementing the change according to the first validity for the first organizational view, and according to the second validity for the second organizational view,” as recited in the limitations of claim 1. No disclosure or even hint exists within *Matheson* of the elements of Applicants claim 1.

Because *Matheson* fails to disclose all limitations of Applicants’ independent claim 1, this claim is not anticipated, and is thus novel. Further, since claims 2-14 depend, either directly or indirectly from claim 1, they too are allowable for at least the same reasons. Further claims 2-14 each may contain additional patentable subject matter.

Moreover, independent claim 15 and its dependent claims 16-28 recite similar limitations as the subject matter of claims 1-14 and therefore are allowable for at least the same reasons.

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<sup>3</sup> Office Action mailed 11/20/08, p. 8

<sup>4</sup> *Matheson*, column 5, lines 22-25

<sup>5</sup> *Matheson*, column 5, lines 26-27

Since Applicants have shown that not all the claimed limitations were known as required by *Net MoneyIn*, Applicants respectfully request the Examiner withdraw the rejection under 35 U.S.C. §102(b) with regard to claims 1-28.

*Reservation of Rights*

In the interest of clarity and brevity, Applicants may not have equally addressed every assertion made in the Office Action, however, this does not constitute any admission or acquiescence. Applicants reserve all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicants do not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicants timely object to such reliance on Official Notice, and reserve all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicants reserve all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

### CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned representative at (408) 660-2015 to facilitate prosecution of this application.


If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
(408) 660-2015

Date 02-12-2009

By

  
Bradley W. Scheer  
Reg. No. 47,059

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on February 12, 2009.

Name

Dawn R. Shaw

Signature

